

REMARKS

Claims 1-22 are currently pending in the application. Claims 5-14 have been withdrawn by the Examiner as being directed to non-elected species. Reconsideration of the rejected claims in view of the following remarks is respectfully requested.

Provisional Obviousness-type Double Patenting Rejection

Claim 1 was provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending application No. 10/605,801 (continuation-in-part application based on the instant application). This rejection is moot in view of the attached Terminal Disclaimer.

While Applicants disagree that claim 1 of the instant application is not patentably distinct from claim 1 of the above-noted copending application, Applicants nevertheless submit that this basis of rejection has been rendered moot inasmuch as Applicants are attaching hereto a Terminal Disclaimer.

Accordingly, Applicants respectfully request that the above-noted rejection of claim 1 be withdrawn.

35 U.S.C. §102 and 103 Rejections

Claims 1-4 and 15-22 were rejected under 35 U.S.C. §102(e) over US Publication 2005/0008945 to BROOKS, or alternatively under 35 U.S.C. §103(a) over BROOKS. These rejections are respectfully traversed.

Under § 1.131, a rejection under 35 U.S.C. § 102(e) or § 103(a) based on a patent or printed publication may, upon a proper showing, be overcome by removing the printed publication as a reference against the claims. Applicants submit that the § 1.131 Declaration submitted herewith is sufficient to remove the BROOKS publication under the § 102(e) rejection and the primary reference of the BROOKS publication under the §103(a) rejection, as a reference and thus is sufficient to overcome the above-noted rejections. More specifically, Applicants submit that the § 1.131 Declaration is formally and substantively sufficient to establish that the Inventors had completed the invention defined in at least claims 1 and 20 (and dependent claims) in the United States before

the effective date of the BROOKS reference, i.e., March 21, 2003. The statements in the Declaration show that the formal requirements of § 1.131 is satisfied, namely:

- (1) the rejections to be overcome are under §§ 102(e) and 103(a);
- (2) all the acts for completing the invention of claim 1 and 20, and those claims dependent thereon were performed in the United States; and
- (3) the effective date of the BROOKS reference (i.e., March 21, 2003) is not more than one year prior to the effective filing date of the present application.

It is respectfully submitted that the statements in the Declaration are also sufficient to satisfy the substantive requirements of 37 C.F.R. § 131. The Declaration sets forth specific facts, of sufficient character and weight, to establish a **date of conception** before March 21, 2003, the effective date of the BROOKS reference, and to show that the Inventors and their attorneys exercised **due diligence** from a time before the effective filing date of the BROOKS reference to a constructive reduction to practice, i.e., to the filing date of the application in the United States on June 30, 2003.

DATE OF CONCEPTION

As stated in the Declaration, the Inventors conceived a method for manufacturing a photomask, comprising steps of forming an opaque layer on a substrate, forming a resist layer on a portion of the opaque layer, and etching the opaque layer by using a gas mixture having a selectivity approximately equal to or higher than 1.2:1 between the opaque layer and the resist layer. The Inventors also conceived a photomask, comprising a substrate and an opaque layer selectively formed on the substrate, the mask being manufactured by steps comprising forming the opaque layer on a substrate, forming a resist layer on a portion of the opaque layer, and etching the opaque layer by

using a gas mixture having a selectivity approximately equal to or higher than 1.2:1 between the opaque layer and the resist layer.

An IBM Invention Disclosure is submitted with the Declaration as supporting evidence of this prior date of conception. It is respectfully submitted that the Invention Disclosure shows that the Inventors had a definite and permanent idea of the complete and operative invention of all the pending claims 1-22 prior to March 21, 2003, the effective date of the BROOKS reference.

Applicants note that the attached invention disclosure labeled "BUR8- -0213" is substantially similar to that provided in US patent application 10/605,801 (a CIP of the instant application) and incorporates therein invention disclosure BUR8-2002-0205, a copy of which is also attached. Invention disclosure labeled "BUR8- -0213" was forwarded to the inventors along with the Declaration and includes the subject matter of invention disclosure BUR8-2002-0205.

In particular, the Invention Disclosure, textually, shows the features of independent claims 1 and 20 (and dependent claims). Also, Applicants note that the original Invention Disclosure shows a date antedating the March 21, 2003 effective date of the BROOKS reference. This and all other pertinent dates have been removed from the photocopies of the Invention Disclosure and accompanying documents submitted with the Declaration to prevent any potential prejudice to Applicants.

Applicants further submit that the Declaration filed herewith shows, unequivocally, that the Inventors had in their possession a definite and permanent idea of the complete and operative invention of the pending claims before March 21, 2003 in a manner sufficient to satisfy the requirements of conception, as set forth in M.P.E.P. 715.07 and 2138.04, and thus constitute *prima facie* evidence of Applicants' date of conception of the invention in this country before the effective date of the BROOKS reference.

DUE DILIGENCE

Applicants further submit that the Declaration shows the Inventors and their attorneys exercised due diligence from a time before the March 21, 2003 effective date of the BROOKS reference to a constructive reduction to practice, realized by the filing of the above-identified parent application on June 30, 2003 in the United States.

The Invention Disclosure was submitted to the IBM review board in July 23, 2002. After approval, a prior art search was performed. The invention disclosure was forwarded to outside counsel thereafter in a timely manner. Discussions between the Inventors and counsel took place until a final application was forwarded to the Inventors for execution, and subsequent filing on June 30, 2003. In particular, discussions between Inventor Steen and outside counsel took place at least in May 2003.

Counsel acted in an expeditious manner to prepare the application for filing. Under M.P.E.P. § 2138.06, only **reasonable** diligence is required in this regard. More specifically, § 2138.06 states that a patent attorney will be held to have exercised reasonable diligence if the attorney worked reasonably hard on the application during the critical period, taking into consideration any backlog of unrelated cases the attorney may have had and his completion of those cases along with the present application in chronological order. Applicants respectfully submit that the Declaration shows that counsel acted sufficiently expeditiously to satisfy the requirements of due diligence.

Applicants submit that the Declaration submitted herewith is sufficient to show that due diligence was exercised as required under 37 C.F.R. § 131. The Inventors remained in regular contact with counsel to answer questions, provide technical explanation, and supply the supplemental disclosure materials necessary for allowing the application to be filed in an expeditious manner.

Accordingly, Applicants respectfully request that the rejection over claims 1-4 and 15-22 be withdrawn.

Rejoinder of non-elected claims

Applicants submit that if claim 1 is found to be allowed or allowable, the restriction/election requirement with respect to withdrawn claims 5-14 would be

improper and should be withdrawn, i.e., claims 5-14 depend from claim 1 and should therefore be rejoined.

Applicants refer the Examiner to MPEP § 821.04 which stands for the proposition that withdrawn claims which depend from or otherwise include all the limitations of the allowable claims will be rejoined if presented prior to allowance and issuance of a final rejection.

As the instant Amendment is being made prior to a final rejection and allowance, Applicant respectfully requests entry and allowance of previously withdrawn claims 5-14, if and when claim 1 is found allowable.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant submits that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 09-0458.

Respectfully submitted,
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